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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,887	10/19/2004	Makoto Kosugi	88562-0001	6372

26021 7590 07/05/2006

HOGAN & HARTSON L.L.P.  
500 S. GRAND AVENUE  
SUITE 1900  
LOS ANGELES, CA 90071-2611

EXAMINER

SCHARICH, MARC A

ART UNIT PAPER NUMBER

3611

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/511,887	<b>Applicant(s)</b> KOSUGI ET AL.	
	<b>Examiner</b> Marc A. Scharich	<b>Art Unit</b> 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/19/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 3-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 3-5, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/19/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/19/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3,4,7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 3 and 4 contain the segment “so as to allow an axis thereof is oriented in a car width direction”. It is unclear to the examiner what constitutes “thereof” and furthermore, it is unclear what the entire phrase is claiming with regard to an axis in a car width direction. Claims 7 and 8 contain the segments “located so as to render an axis thereof inclined relative to a vertical direction” and “located so as to render an axis thereof inclined relative to the vertical direction”. It is unclear to the examiner what constitutes “thereof” with respect to the current claim language. The examiner suggests rewording the above stated segments to clarify the subject matter that is being claimed.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hori et al., U.S. Patent No. 6,357,545. Hori et al. discloses a motorcycle (1) containing

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an engine (3) supported by a frame (10) [containing left and right main sections 10l, 10r]; a cylinder block [containing left and right cylinders 4l and 4r] constituting a part of the engine (3); a crankcase (8) located below the cylinder block; a transmission [inside transmission case 9] being located behind the crankcase (8) and including a multistage shifting mechanism (col. 11 lines 1-4) having multistage change gears [merely by its generic function and definition, a typical transmission, as disclosed in Hori et al., contains a multistage shifting mechanism having multistage change gears]; a shift [transmission] actuator (72) configured to shift the change of gears of the transmission through a link mechanism; and a clutch (69) configured to connect/disconnect transmission of rotation when shifting the change gears of the transmission; and a clutch actuator (71) configured to actuate the clutch through a link mechanism, and both shift actuator (72) and clutch actuator (71) being located *behind* the cylinder block. *It is not distinctly disclosed* in Hori's invention, however, that the shift and clutch actuators are formed into a tubular shape, but it is well known in the art that such actuators may be formed into a variety of shapes, depending on the placement of the actuator and the application. Furthermore, a tubular shape would be more aerodynamic with airflow when a vehicle travels, therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include shift and clutch actuators that are formed into tubular shapes to be more aerodynamic to the airflow generated when the motorcycle is traveling and perhaps collect less grime or debris from the environment.

***Allowable Subject Matter***

3. Claim 6 is allowable due to finding no prior art *specifically* disclosing or teaching a motivation for containing: *a clutch actuator and a shift actuator located separately on left and right sides so as to sandwich a center of a tire in a space between straight lines respectively connecting a tread surface of the tire and tips of left and right pairs of steps from frontal viewpoint.*

Claims 7 and 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Fritzenwenger, U.S. Patent No. 4,388,979; Bevins, U.S. Patent No. 5,299,652; Walker, U.S. Patent No. 6,131,682; Gagnon et al., U.S. Patent No. 6,257,081; Matsuto et al., U.S. Patent No. 6,276,481; Tsutsumikoshi, U.S. Patent No. 6,405,821; Gagnon et al., U.S. Patent No. 6,524,224; Drussel et al., U.S. Patent No. 6,705,446; and Maimone, U.S. Patent No. 6,910,563. The above listed prior art pertains to the structure and arrangement of straddle-type vehicle power trains and power units, or controls of the power trains and power units, including the placement of engines, transmissions, shifting mechanisms, and clutch mechanisms.

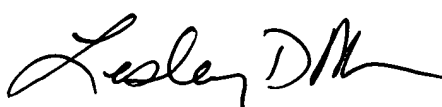
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A. Scharich whose telephone number is (571) 272-3244. The examiner can normally be reached on M-F 8:30 a.m. - 5:00 p.m..

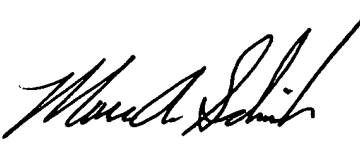
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

M.A.S. 6/23/2006

  
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**Marc A. Scharich**  
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